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CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION
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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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3621

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12/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,108	Applicant(s) MATSUDA ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,23,27-33 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,23,27-33 and 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/5/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 30 September 2008 has been entered.

Acknowledgements

2. Claims 22, 23, 27-33, and 37-42 are pending.
3. Examiner acknowledges Applicants' title change, and thanks Applicants for the change.

Claim Objections

4. Claims 22, 23, and 27-31 are objected to for usage of the functional language “configured that”. It is believed that Applicants intend “configured that” to mean “programmed to ” since “configured” is functional language and therefore given less patentable weight¹. In light of the notice function of the claims, the Examiner respectfully requests changing “configured that” to “programmed to ” where a positive recitation is desired².

¹ The Examiner reasserts this point, previously asserted in the Office Action of 30 June 2008, and requests for the second time that the language be changed to "programmed to".

² See MPEP §2114 - “While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function” (emphasis mine). The Manual then cites important precedent: “In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “Apparatus claims cover what a device

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 32, 33, and 37-41 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

7. Based on Supreme Court precedent³ and recent Federal Circuit decisions⁴, a §101 process must (1) be tied to a machine (e.g. a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.⁵ If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

8. In this particular case, the method in independent claim 32 is not tied to a particular machine, nor does it transform underlying subject matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).”

³ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

⁴ See especially *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (*en banc*).

⁵ The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 22, 23, 30-33, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent 5,974,150 ("Kaish") in view of the Microsoft Computer Dictionary, Fifth Edition ("Microsoft").

11. As per claims 22, 23, 30, 32, 33, 40, and 42, Kaish discloses:

12. database configured that stores registered trademark image information (figure 1, reference 5) and genuine-product-specific information corresponding to the product name (figure 1, reference 3, 4);

13. input unit configured that inputs product data acquired by scanning a product (figure 2, reference 35-39, 41);

14. determining unit configured that determines that the product is a genuine product when the determining unit determines that the product data input by the input unit includes the registered trademark information and the genuine-product-specific information in the database corresponding to the product name input in the input screen (column 9, lines 12-22; column 10, line 57 - column 11, line 2 - "unique, random, or quasi-unique characteristic of the item is encoded on the label"; column 27, lines 20-30 - "sheet of material...code number...manufacturing information, such as serial number, date, location, lot number, copyright notice");

15. determines that the product is a counterfeit product when the determining unit determines that the product data input by the input unit includes the registered trademark image information in the database corresponding to the product name input in the input screen (column 27, lines 20-30 - "fiber pattern, which is random (irregular), is illuminated..."; column 28, lines 7-30 -

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"medium is then scanned, and an analogous vector mapping derived from the newly scanned image. The recorded vector map is compared with the measured vector map...");

16. product includes toner for a printer (the Examiner contends that this is an intended use of the invention, as such, it is not given patentable weight. Furthermore, there is nothing preventing the system in Kaish from being used as a printer toner counterfeit detection system, instead noting that "electronics and software products are also particular targets of counterfeiters" (column 1, lines 53-56)).

17. Kaish does not explicitly disclose:

18. providing unit configured that provides an input screen for inputting a product name;

a. Kaish does not explicitly disclose that the product name may be inserted, instead relying on a scanner to interpret the label's text (figure 2, reference 30, 31, 32). Note in column 17, lines 11-15 - "manually or automatically verifies the printed code on the label". One such method of "automatically" verifying the printed code on the label is through Optical Character Recognition ("OCR")⁶. One alternative to scanning data is to manually type the text data printed on the paper, using such items as a keyboard or a "touch screen" (defined by Microsoft as a "computer screen designed or modified to recognize the location of a touch on its surface" (page 524), enabling a human user to enter data as he would on a keyboard or any other device).

b. The sole difference between the reference and the instant application is that the reference does not disclose entering data manually using a touch screen, in place of

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scanning the data using a scanner. Since each individual system of entering data into a computer and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of a touch screen in Kaish. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a touch screen in place of scanning the , because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious. A person having ordinary skill in the art would see the substitution as advantageous, because it would allow for a backup method of

19. determines that the product is neither genuine nor counterfeit, when data input by the input unit does not include the registered trademark image information in the database corresponding to the product name input in the input screen, determining that the product is a third party product.

c. The Examiner notes that the purpose of this patent application is "identifying a counterfeit product" (§1, instant application). As such, a counterfeit product would be one that purports to be from a company that it is not originating from (such as in figure 8, instant application). It is an undisputed fact that if a human being were to look at a toner from another company (such as Samsung), this human being would NOT attempt to recognize that toner as a Canon-brand toner - instead noting that the toner is likely from a "third party" (i.e. it is not a Canon-brand toner, nor is it a counterfeit Canon-brand toner). Similarly, if a human being observed a Motorola-brand phone, the human being would

⁶ Microsoft discloses that OCR operates by "[examining] printed characters on paper and [determining] their shapes

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NOT recognize the phone as being either a Nokia-brand phone or a counterfeit Nokia-brand phone, instead recognizing that this phone is from a "third party".

d. Kaish does not explicitly disclose that its system believes a product to be from a third party, when said product lacks the registered trademark information. However, it would have been obvious to a person having ordinary skill in the art to provide an automatic mechanism for performing this same task. See MPEP §2144.04(III) and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958): "broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art".

e. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an automatic step of noticing that the product is from a third party when it does not contain markings identifying it as a first party, as it allows for counterfeit verification more quickly, something that a person having ordinary skill in the art would see as advantageous.

20. As per claims 31 and 41, Kaish discloses:

21. storing determination result (figure 2, reference numbers 20, 24; figure 3, reference numbers 45, 48, 55; figure 4a, reference numbers 106, 107).

22. Claims 27-30 and 37-40 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish in view of Microsoft, further in view of Admitted Prior Art.

by detecting patters of dark and light" (page 379).

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23. As claims 27-30 and 37-40 are best understood by the Examiner, Kaish teaches:

24. information is written in a micro-character;

f. see Figure 1, reference numbers 8, 10. Kaish does not explicitly disclose using a micro-character to further the security of the system. It is now Admitted Prior Art (under MPEP §2144.03(c)) that using micro-characters for providing a higher lever of visual security was well known to those skilled in the art at the time of the invention. These characters were well known to those skilled in the art at the time of the invention to provide an easily-authenticated system of physical objects. Due to the desire to easily authenticate items using micro-characters being well known to those skilled in the art at the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use micro-characters in conjunction with the system in Kaish, to give a higher degree of security. A person having ordinary skill in the art would understand that the usage of micro-characters would be advantageous, since it provides for a more easily-authenticated system that is harder to forge;

25. configured to notify another terminal of a determination result obtained by the determining unit;

g. see column 25, lines 42-49. Kaish does not explicitly disclose that the user information is transmitted to the remote site. There is a desire in the system in Kaish to provide a secure method of authenticating products – evidence exists in column 26, lines 33 – 36. Clearly there is a desire for security, and sending along the authenticated user information would allow for a higher degree of security in the system. It is now Admitted Prior Art (under MPEP §2144.03(c)) that user information is transmitted to the

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remote site. Additionally, it was obvious to one skilled in the art at the time of the invention to send usernames with secure communication, in order to authenticate transactions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the user information to the remote site, in order to provide a higher level of security. A person having ordinary skill in the art would understand this to be advantageous, as it provides more security;

26. when the unit determines that a product is a counterfeit product, the unit notifies a counterfeit product's regulatory authority terminal of the determination result;

h. Kaish does not explicitly teach that a regulatory authority terminal receives notification of the determination result. It is now Admitted Prior Art (under MPEP §2144.03(c)) that notifying a regulatory authority of counterfeit products was old and well-known in the art because this is how most regulatory authorities receive information on such products, by self-reporting of individuals receiving counterfeit items. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kaish to send information to a regulatory authority of the counterfeit nature of the scanned product, because it would enable a more informative and helpful (in stemming the problem of counterfeiting) system, something that a person having ordinary skill in the art would see as advantageous.

27. product includes toner for a printer.

i. It is the examiner's primary position that the claims are anticipated because of the inherent feature (i.e. using the invention in Kaish to identify printer toner). However, if not inherent, then it is now Admitted Prior Art (under MPEP §2144.03(c)) that anti-

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counterfeiting equipment and methods were old and well-known in the art of printer toner manufacturing. Numerous manufacturers have implemented anti-counterfeiting measures for printer supplies. This is done to prevent counterfeit printer toner from undercutting manufacturers' sales and adversely affecting the printers they are used on. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Kaish on printer toner, as it would create a more powerful and profitable situation for the printer toner manufacturer, something that a person having ordinary skill in the art would understand as being advantageous.

Claim Interpretation

28. In accordance with MPEP §2111.01, the Examiner has interpreted the meaning of claim limitations in accordance with their "plain meaning", unless such terms have been specified defined explicitly in the specification.

29. As it is written, the Examiner interprets independent claim 22 to read "a providing unit, a database, an input unit, a determining unit". The "configured" portion of the claim does not add patentable weight, and is considered to be purely functional language. Consider a desk chair. It can be said that a desk chair is "configured" to stand upon - while this is clearly not the intended use of the chair, the chair is "configured" to do so. A stepladder would be "programmed" (in a sense) for standing upon, as it contains a stepping portion and steps to ascend the ladder. The idea of intended use is the question at hand here.

30. The Examiner does not feel that "configured that" sufficiently discloses the structure of the apparatus in claims 22-31. As the use of "programmed to" would positively recite the

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intended function of the individual units (in a way that is sufficiently to distinguish it from the prior art), the Examiner again requests that Applicants use this terminology to claim their invention.

31. Independent claim 22 contains optional language. The determining unit comes to one result when the product data includes the trademark image and the genuine-product-specific information, or another result when the trademark image is present but the specific information is not, or another result when the trademark image is not present. This is "optional language" as it provides for alternatives in the same apparatus. Such optional elements "do not narrow the claim because they can always be omitted"; see *In re Johnston*, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006). As such, a determining unit meeting *any* of the enumerated possibilities recited in claim 1 would meet the claim language.

32. Independent claims 32 and 42 both contain a step for determining whether a product is genuine, counterfeit, or a third party product. The claims do not specify what the answers of the first two determining steps must be, in order to end up with "genuine", "counterfeit", or "third party" as determinations in the third step. This has been interpreted to mean that any the first two determining steps may result in any answer in order to reach any conclusion. As this is likely what Applicants are not trying to claim, the Examiner recommends expanding upon which determinations lead to which answers.

Response to Arguments

33. Applicants' arguments with respect to the art rejections have been considered but are moot in view of the new ground of rejection. They appear to argue limitations that were not

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previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

34. Applicants' arguments with respect to non-art rejections (such as the 35 U.S.C. §101 rejection) have been considered but are not persuasive.

35. As for Applicants' argument that claims 32-41 are statutory, the Examiner cites the recently-decided case *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (*en banc*). See especially *Bilski* at 1396: "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70." As independent claim 32 does not tie itself to a particular machine, nor transform an article of manufacture, the claim is non-statutory. A "database" is not a machine.

36. Applicants may argue that the "input screen" is a sufficient tie to a "particular machine". This is faulty for two reasons - firstly, the "input screen" is not a "particular" machine, as it could be implemented in any number of ways, including but not limited to a mouse pointer on a computer monitor, a touch screen, or a keyboard for typing to a computer (which displays the data that has been typed). No "particular" machine is recited in the claims.

37. Secondly, the method is hardly tied to the screen. To be "tied" to the screen would mean that the method would not operate without the particular screen. However, the Examiner has above established that the screen is merely one method of entering data, so the method is hardly dependent upon the screen itself for operation (as data can come from a number of sources, including but not limited to network data, visual data (such as a webcam or a scanner), manually entered data from a keyboard, atmospheric data, *et cetera*.

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38. The use of an said screen fails to impose any meaningful limits on the scope of independent claim 32, as it adds nothing more than an input device for facilitating the entry of data. This recitation of an "input screen" is a field-of-use limitation, and it is insufficient to render an otherwise-ineligible process claim as eligible. *Arguendo*, if it *were* sufficient, it would allow for pre-emption of the principles present in a method that does not explicitly tie to an "input screen".

39. Finally, the Examiner feels that the method as claimed is easily performed by a human, and as such any patent on this implementation would pre-empt such actions. Visually perceiving whether marks exist in a database and on a product would be prevented from being performed.

40. As per Applicants' arguments concerning the Official Notices, Applicants' attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 20080624, Paragraph No. 18-19) is inadequate. Adequate traversal is a two step process. First, Applicant(s) must state their traversal on the record. Second, and in accordance with 37 C.F.R. §1.111(b), which requires Applicants to specifically point out the supposed errors in the Office Action, Applicants must state why the Official Notice statements are not to be considered common knowledge or well known in the art.

41. In this application, while Applicants have clearly met step (1), Applicants have failed step (2) since they have failed to argue why the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicants' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP §2144.03.

Conclusion

42. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449 form are cited in their entirety.
43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.
44. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns
Examiner
Art Unit 3621

CCJ

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Supervisory Patent Examiner, Art Unit 3685